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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,832	01/31/2002	Stefan Lehner-Dittenberger	VOI0218.US	4348

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EXAMINER
JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
3726	

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/062,832	LEHNER-DITTENBERGER, STEFAN	
	Examiner	Art Unit	
	Marc Jimenez	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the faxed copy of the declaration received is difficult to read because of the print quality.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 10-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites "said resilient layer having a constant radial rigidity over an axial length" in line 2 which contradicts the limitations in claim 1 which recites "said radial rigidity of each said resilient member varying over said roller length".

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 12 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper

No. 7 filed 2/24/03. In that paper, applicant has stated that the base body is substantially cylindrical as claimed in claim 1, which is easier to construct than the conically shaped base roll of Pessen (page 4 2nd full paragraph), and this statement indicates that the invention is different from what is defined in the claim(s) because claim 12 recites that the base body is tapered toward each of the two roller ends.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 2, 5-8, 13, 15, and 17-23** are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (4,974,782).

Nelson teaches a roller for winding of a material web thereon, the roller having two roller ends and a mid roller area, the roller having a maximum winding diameter associated therewith, the roller comprising: a base body **35** being substantially cylindrical, at least one resilient member **50**, the at least one resilient member **50** being at least one of a resilient layer **38** (fig. 1) applied to at least sections of the body **35** and at least one resilient element **50** (fig. 2) positioned on the base body **35**, the at least one resilient member **50** being positioned and configured so as to make the roller radially more resilient near each of the roller ends than in the mid-roller area (abstract, last five lines) in order to at least partially compensate for a deflection of the base body

35 at the maximum winding diameter, the roller has a roller length, each resilient member **50** having a radial rigidity, the radial rigidity of each resilient member **50** varying over the roller length (abstract, last five lines), and a circumferential surface **30** positioned over the base body, the circumferential surface **30** contacting the material web, the circumferential surface **30** being one of integral with and separate from the at least one resilient member **50**.

Note that there are rigid support points at the mid point of the base body **35** and axially along the base body which are surrounded by the circumferential surface **30**, the circumferential surface **30** being radially less resilient in a vicinity of the rigid support point on the mid point than near the two roller ends (abstract, last two lines). The claimed "rigid support points" have no defined structure, but are merely "points" along the base body. The resilient layer **38** has constant thickness (fig. 1) increasing in radial resilience toward the ends. The resilient members **50** are axially distanced (fig. 2-4). Note that the spring elements **50** are elastomeric materials (col. 2, lines 4-8). The resilient elements **50** are prestressed by force **F**. the resilient elements are "spring packets". See also U.S. patent no. 3,750,246 to Pessen who defines resilient elements as being "spring packets" (col. 12, line 53).

7. **Claim 3** is rejected under 35 U.S.C. 102(b) as being anticipated by Pessen (3,750,246).

Pessen teaches a base body **22** varying in diameter from the mid roller area **22** to the ends **12,14** in a substantially parabolic manner (col. 1, lines 11-18 and col. 7, lines 12-13), the deflection forces cause the body **22** to bend, also in col. 8, lines 53-54, the body could be curved (hence substantially parabolic), at least one resilient member **D**, the at least one resilient member **D** being at least one of a resilient layer and at least one resilient element making the roller

radially more resilient near the ends than in the mid roller area to compensate deflection of the base body (col. 7, lines 12-13) at the maximum winding diameter, the thickness of the resilient member **D** varies in radial thickness, and a circumferential surface **C** being one of integral and separate from the at least one resilient member **D**.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 9, 14, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson.

Nelson teaches the invention cited above with the exception of the resilient tube being a coating of rubber or another elastomeric material.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Furthermore, on page 3, last two lines to page 4, first line of applicant's specification, the particular use of resilient material could be metal, rubber, or other similar material. Therefore, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used rubber or other elastomeric material for the tube, because applicant has not disclosed that using rubber or other elastomeric material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the metal tube taught by Nelson or the claimed resilient tube material because either type of material for the tube perform the same function of covering the resilient member equally well. Therefore, it would have been an obvious matter of design choice to modify Nelson to obtain the invention as specified in claims 9 and 16.

Nelson teaches the invention cited above with the exception of the at least one resilient member being formed of a non-homogeneous layer of at least one of a foamed material and a honeycomb structure.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Furthermore, at the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used at least one resilient member being formed of a non-homogeneous layer of at least one of a foamed material and a honeycomb

structure, because applicant has not disclosed that using at least one resilient member being formed of a non-homogeneous layer of at least one of a foamed material and a honeycomb structure provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the resilient material taught by Nelson or the claimed resilient material because either type of material perform the same function providing a resilient layer equally well. Therefore, it would have been an obvious matter of design choice to modify Nelson to obtain the invention as specified in claim 14.

10. **Claims 3, 4, and 10-12** are rejected as best understood under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Pessen (3,750,246).

Note that claims 10-12 were also rejected under 35 U.S.C. 112 2nd paragraph above because the scope of the claims are unclear.

Nelson teaches the invention cited with the exception of the resilient layer having a constant radial rigidity and increasing in thickness toward the ends and the base body tapering toward the ends.

Pessen teaches a resilient layer **D** having a constant radial rigidity and increasing in thickness toward the ends **12,14** and the base body **22** tapering toward the ends.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Nelson with a resilient layer having a constant radial rigidity and increasing in thickness toward the ends and the base body tapering toward the ends, in light of the teachings of Pessen, in order to provide improved controlled deflection of the roll.

11. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Pessen in view of Nelson.

Pessen teaches the invention cited with the exception of the radial rigidity of each resilient member varying over the roller length.

Nelson teaches that the radial rigidity of each resilient member varies over the roller length (see recitations above).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Pessen with the radial rigidity of each resilient member varying over the roller length, in light of the teachings of Nelson, in order to provide better control of the load bearing characteristics of the roller.

12. **Claims 24-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Pessen (3,750,246).

Nelson teaches the invention cited above (see also fig. 1) with the exception of having tension anchors.

Pessen teaches tension anchors (col. 3, lines 36-41).

It would have been obvious to one of ordinary skill in the, at the time of the invention, to have provided the invention of Nelson with tension anchors, in light of the teachings of Pessen, in order to provide a better grip between the roller tube and base body. Note that Pessen also teach spacers **36**.

Response to Arguments

13. Applicant's arguments with respect to Claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Interviews After Final

15. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Contact Information

16. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http:www.uspto.gov/

MJ
March 14, 2003

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